

## **REMARKS**

This paper is responsive to the Office Action mailed April 7, 2004. The recognition of allowable subject matter in **claims 31 and 32** is noted with appreciation. Nevertheless, amendment, reexamination and reconsideration of the application are respectfully requested.

### **The Office Action**

In the Office Action mailed April 7, 2004:

**Claims 1 and 3** were reinstated;

**Claims 1, 3, 17-22 and 33** were rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 2,942,314 to Debner et al. ("Debner");

**Claims 11-13** were rejected under 35 U.S.C. §102(b) as being anticipated by Condon; and

**Claims 23-25, 29 and 30** were rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 5,230,488 to Condon ("Condon") in view of U.S. Patent No. 1,662,539 to Schmidt ("Schmidt").

### **Reply to the Response to Applicants Arguments**

In responding to the Applicants argument that Debner does not disclose three protrusions or ribs, the Examiner asserted that Debner's hook **16** comprises a vertical hook portion constituting an arm and a curved portion constituting a protrusion or a rib. However, as used in the present application, an arm comprises a stem extending upward from a surface and a flange supported in a cantilevered manner from the stem (e.g., see page 23, lines 8-12). **Claims 11, 17 and 23** have been amended to recite a stem and a flange. Additionally, Merriam-Webster's Collegiate Dictionary 11<sup>th</sup> Edition defines a rib as, among other things, an elongated ridge: as a (1): a vein of an insect's wing (2): one of the primary veins of a leaf. This definition is clearly embraced by the present application. For example, see FIGS. 5A-5C and page 20, line 5. It is also respectfully submitted that the S-shaped members of Debner do not disclose or suggest protrusions as disclosed and claimed in the present application. For example, the surfaces near reference numeral **17** appear flat and smooth and do not include or consist of protrusions as the term is used in the present application.

In apparent response to the Applicant's argument that Debner is non-analogous art, for reasons including that Debner is unconcerned with engaging planar surfaces of a ceiling grid, the Office Action asserts that the "Applicant is not claiming planar

surfaces with ceiling grid”; thus such argument is irrelevant.

The Applicant respectfully disagrees. **Claim 11** clearly recites a ceiling grid banner hanger. **Claim 17** clearly recites a ceiling grid banner hanger operative to suspend a sign from an associated ceiling grid. **Claim 23** clearly recites a one piece ceiling grid object hanger, and **claim 33** clearly recites a ceiling grid banner hanger operative to suspend a sign from an associated ceiling grid. Exemplary ceiling grids are described in the present application as “T”-shaped and as including horizontal flanges (e.g., 80 in FIGS. 4A and 4B).

In contrast, Debner discloses a double ended cord holder for clamping two cord lengths in parallel relation. Debner is particularly focused on a cord holder for use with electrical appliances so that the power supply cord may be neatly fastened around an appliance such as a toaster, vacuum cleaner or flat iron, when the cord is not in use (column 1, lines 15-20). It is respectfully submitted that the double ended cord holder of Debner is not analogous art to a ceiling grid banner hanger or a ceiling grid object hanger. Additionally, it is respectfully submitted that the double ended cord holder of Debner could not even be installed on a ceiling grid. For example, it is respectfully submitted that S-shaped members **11** and **13** are too thick as measured from the surfaces near reference numeral **17** to the top and bottom of the S-shapes (near **14** and **15**) to allow installation on a ceiling grid. Additionally, because the width of the S-shapes extend beyond the longitudinal axis (e.g., in the direction of 20 as asserted by the Office Action). The S-shaped members **11** and **12** would engage the vertical support member (e.g., depicted by two closely spaced vertical lines on ceiling grid horizontal flange **80** depicted in FIG. 4A of the present application or the portion of the I-beam near reference numeral **22** in Schmidt) before being fully installed on the ceiling grid. Additionally, it is respectfully submitted that even if the S-shaped members **11** and **12** of Debner are considered to include stems, cantilevered flanges, and protrusions, the S-shaped members **11** and **12** (referred to as **16** by the Office Action) do not include ridges or ribs as recited in **claim 33**.

Lastly, it is respectfully submitted that the gap between the surfaces near reference numeral **17**, in the double ended cord holder of Debner, and their opposing unnumbered surfaces, is too large to provide a securing fit were an attempt made to install the double ended cord holder of Debner on a ceiling grid.

The Office Action did not respond to Applicants’ arguments regarding the Schmidt reference. Nevertheless, both the previous and present Office Actions appear

to equate the rabbets **30** of Schmidt with the first and second tapered walls recited in **claim 23**. However, the first and second tapered walls of **claim 23** cooperate to engage an associated ceiling grid member with progressively firmer grip as the object hanger is rotated from a disengaged position relative to the associated ceiling grid into an engaged position. In contrast, the clamping shoes **28** of Schmidt are not rotated into position as disclosed and claimed in the present application. Instead, they are bolted into position, with nuts **35** being received about bolts **34** for clamping the hanger plate in the shoes to the eye beam (page 1, lines 86-92). The rabbets **30** simply allow the shoes **28** to conform to the lower flange **29** of the eye beam. They do not provide a progressively firmer grip as the object hanger is rotated from a disengaged position relative to the associated ceiling grid into an engaged. Instead, it is submitted that the hanger plate of Schmidt must be held in place while the bolts **34** and nuts **35** are used to secure the shoes to the eye beam. The rabbets **30** simply allow the shoes to evenly engage the eye beam when they are so installed. Thus, Schmidt does not have a rotational axis as recited in **claim 23**. Additionally, the support means for overhead tracks of Schmidt includes a plurality of pieces (e.g., bolts **34**, nuts **35**, shoes **28**, etc.). One concerned with the designing of a one piece ceiling grid object hanger would not look to Schmidt. Therefore, Schmidt is non-analogous art and is not properly applied in combination with Condon, or any other reference, against the claims of the present application.

Since the Office Action did not respond to these arguments, no clear issue has been developed between the Applicant and the Examiner. Therefore, it is respectfully submitted that the finality of the present rejection is premature. Withdrawal of the finality of the present rejection and clarification of the position of the Examiner is respectfully requested.

#### **Claims 31 and 32 are Allowable**

The Office Action stated that **claims 31 and 32** would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. **Claims 31 and 32** have been rewritten in independent form including all of the limitations of the base claim and any intervening claims. For at least the foregoing reasons, it is respectfully submitted that **claims 31 and 32** are allowable.

**Claims 11, 12, 17-22 and 33 are Not Anticipated**

**Claims 1, 3, 17-22 and 33** were rejected under 35 U.S.C. §102(b) as being anticipated by Debner. In explaining this rejection the Office Action asserts that Debner discloses a hanger. However, it is respectfully submitted that Debner does not disclose a hanger. As explained above, Debner discloses a double ended cord holder for securing a power supply cord of a toaster, vacuum cleaner or flat iron. The cord holder of Debner does not suggest or recommend itself for use as ceiling grid object hanger, or indeed, as any type of hanger. Even if some portion of the S-shaped members of the cord holder of Debner could be installed on a ceiling grid, the adjacent ceiling tiles would be dislocated and forced askew in a most unsatisfactory manner. The only motivation to include any aspect of the cord holder of Debner in a ceiling grid object hanger as recited in the instant claims is found in the present application.

**Claims 1 and 3** have been canceled. It is respectfully submitted that Debner does not anticipate **claims 17-22 and 33**. Furthermore, any rejection based on a combination including Debner would be based on impermissible hindsight. Reconsideration is respectfully requested. For at least the forgoing reasons, **claims 17-22 and 33** are not anticipated by Debner.

**Claim 17** has been amended to recite a first stem extending away from said top side, a first flange supported in a cantilevered manner from the first stem, a first protrusion extending from said first flange toward said top side, a second stem extending away from said top side, a second flange supported in a cantilevered manner from said second stem, a second protrusion extending from said second flange toward said top side, wherein said first stem and flange are located completely on a first side of said longitudinal axis and said second stem and flange are located completely on a second side of said longitudinal axis.

As explained above, even if the S-shaped members **11** and **12** of Debner are arbitrarily subdivided into a stem, a flange and a protrusion, the S-shaped members extend beyond and are not completely on one side of the longitudinal axis (in the direction of **20** as asserted by the Office Action).

For at least these additional reasons, **claim 17**, as well as **claims 19-22**, which depend therefrom, are not anticipated by Debner.

Furthermore, it is respectfully submitted that **claim 17** is not obvious in light of Debner, Condon and Schmidt taken alone or in any combination. For example, **claim 17** also recites a third protrusion extending upwardly from said top side wherein said

first, second and third protrusions engage planar surfaces of an associated ceiling grid to resist disengagement of said support body from said associated ceiling grid and wherein said first, second and third protrusions releasably grip opposed surfaces of the associated ceiling grid to which the support body is selectively secured so that said support body can be manually removed without a need for tools to dislodge said first, second and third protrusions from contact with the associated ceiling grid. As explained above, the double ended cord holder of Debner can not be installed on a ceiling grid and Debner makes no suggestion that it could. Condon discloses stems and cantilevered flanges. However, Condon does not disclose or suggest first and second protrusions extending from said flanges. Schmidt discloses shoes **28** having a rabbets **30**. The rabbets **30** have an upper wall **31** corresponding in form to the form of an upper surface at the respective edges of a flange **29** (page 1, lines 73-81). The shoes **28** are clamped to the flange **29** with bolts **34** and nuts **35** (page 1, lines 86-90). Therefore, it is respectfully submitted that Schmidt does not disclose or suggest protrusions that releasably grip opposed surfaces of an associated ceiling grid to which the support body is selectively secured so that said support body can be manually removed without a need for tools to dislodge said first, second and third protrusions from contact with the associated ceiling grid.

Furthermore, it is respectfully submitted there is no motivation in the art to combine the rabbets from the bolted on shoes **28** of Schmidt with the flanges **32** and **34** of Condon. It is respectfully submitted that Condon asserts that spring forces associated with the compression of clamp portion **12** into gap **16** during an installation process (column 3, lines 41-59) are sufficient to secure the pipe hanging clamp of Condon to the strap **17** (column 3, lines 50-52). Condon does not disclose or suggest that there is a need for increased gripping forces. Therefore, there is no motivation to provide first, second and third protrusions on the clamp of Condon for such a purpose. Gripping forces in the support means of Schmidt, are provided by the torque applied to nuts **35**. The rabbets **30** of Schmidt are provided merely for conforming to the shape of the flange **29** and they are not for increasing gripping forces. Therefore there is no disclosure or suggestion in Schmidt or Condon for modifying the shape of L-shaped flanges **30**, **32** and **34** to increase a gripping force or for any other reason. Any suggestion to do so can only have been found in the present application. Therefore, any rejection of **claim 17**, based on the combination of Debner, Condon and Schmidt can only, it is respectfully submitted, be based on impermissible hindsight.

For the foregoing reasons, **claim 17** as well as **claims 19-22**, which depend therefrom, are neither anticipated nor obvious in view of Debner, Condon and Schmidt taken alone, or in any combination.

It is respectfully submitted that the amendments to **claim 17** are supported throughout the specification. For example, see page 23, lines 10-12 and original **claim 18**.

With regard to **claim 33** the Office Action asserts that Debner's hook **16** can be divided into a vertical hook portion, constituting the arm, and a curved portion, constituting the protrusion or rib. The Applicants respectfully disagree. As explained above, Merriam Webster's Collegiate Dictionary, 11<sup>th</sup> Edition defines a rib as an elongated ridge: as a (1) a vein of a insect's wing (2): one of the primary veins of a leaf. This is the definition of rib embraced by the present application. For example, see reference numerals **340** and **356** in FIG. 5A - FIG. 5C as well as page 20, lines 4-9.

For at least the foregoing reasons, **claim 33**, as well as new **claim 43**, which depends therefrom is unanticipated by Debner.

Furthermore, neither Condon nor Schmidt disclose or suggest a rib as disclosed in the present application and recited in **claim 33**. For at least the foregoing additional reasons, **claim 33**, as well as new **claim 43**, which depends therefrom, is unanticipated and is not obvious in light of Debner, Condon and Schmidt taken alone or in any combination.

Additionally, new **claim 43** recites longitudinal axes of the first and second ribs extend in a direction parallel to said longitudinal axis of said support body. New **claim 43** is supported in the figures. For example, see FIG. 5B and FIG. 8B. It is respectfully submitted that Debner, Condon and Schmidt do not disclose or suggest a rib having a longitudinal axis extending in a direction parallel to a longitudinal axis of a support body.

For at least the foregoing additional reasons, new **claim 43** is unanticipated and is not obvious in light of Debner, Condon and Schmidt taken alone or in any combination.

**Claims 11-13** were rejected under 35 U.S.C. §102(b) as being anticipated by Condon.

In explaining this rejection the Office Action asserts that Condon discloses a first arm and a first protrusion and a second arm with a second protrusion and points generally to what Condon refers to as L-shaped flanges **32** and **34** in support of this assertion. However, **claim 11** has been amended to recite (briefly) a first stem, a first

flange, a second stem, a second flange, a first protrusion depending from said first flange and a second protrusion depending from said second flange. It is respectfully submitted that these amendments are supported throughout the specification. For example, see page 23, lines 10-12 as well as original **claim 13**.

The subject matter of **claim 13** has been included in **claim 11** and **claim 13** has been canceled.

It is respectfully submitted that Condon does not disclose or suggest a first protrusion depending from a first flange and a second protrusion depending from a second flange. Therefore, **claim 11**, as well as **claims 12, 14-16 and 34-42**, which depend therefrom, is unanticipated by Condon.

Furthermore, it is respectfully submitted that **claim 11** is not obvious in light of Condon and Schmidt because, there is no motivation in them to make such a combination. Condon does not disclose or suggest that additional gripping force is required and Schmidt does not disclose or suggest that the shape of the shoes **28** or rabbits **30** is for the purpose of increasing a gripping force or a force to resist disengagement of the support body from a ceiling grid. Instead, Schmidt discloses that the shape of the rabbits **30** is to conform to the shape of the lower flange **29** of the I-beam **22** and that gripping forces are provided by tightening nuts **35**. Shaping the flanges recited in **claim 17** to conform to the shape of the ceiling grid would result in a flange without a protrusion because ceiling grid flanges can be substantially flat.

For at least the foregoing reasons, **claim 11**, as well as **claims 12, 14-16**, which depend therefrom, is not anticipated and is not obvious in light of Condon and Schmidt taken alone or in any combination.

**Claims 14-16** were mistakenly withdrawn in response to the restriction requirement. However, the restriction requirement stated that **claims 11-13** are generic. It is respectfully submitted that **claim 11** remains generic even after the present amendment. Therefore, it is respectfully requested that **claims 14-16** be reinstated. **Claims 14 and 15** have been amended to correct antecedents in keeping with the amendments to **claim 11**. New **claims 34-42** include subject matter similar to that recited in original **claims 2-10**. However, that subject matter has been re-presented to properly depend from **claim 11**.

Regarding **claim 14**, it is respectfully submitted that none of the cited references disclose or suggest a third stem and flange and a fourth stem and flange in the recited orientation. **Claim 15** depends from **claim 14** and recites additional detail.

For at least these additional reasons, **claims 14 and 15** are unanticipated and are not obvious in light of Debner, Condon and Schmidt taken alone or in any combination.

New **claim 34** recites that the first and second arms each further comprise a first region, for engaging the associated ceiling grid early in an installation process, and a second region, for engaging the associated ceiling grid later in the installation process, wherein first protrusion is located on said second region of said first arm and said second protrusion is located on said second region of said second arm. New **claim 35** recites the banner hanger further comprises a first attachment means located on said first object support flange for supporting an object. New **claim 36** (briefly) recites a second portion extending from said support body a predetermined distance away from a pivot axis of said support body in a first direction parallel to said longitudinal axis and a third portion extending from said support body a predetermined distance away from said pivot axis, parallel to said longitudinal axis in a second direction opposite the first direction. New **claim 37** recites a third stem and flange extending away from said second portion and a fourth stem and flange extending away from said third portion. New **claim 38** recites said second object support flange includes means to attach an object, said second object support flange extending from said second portion and said banner hanger further comprises a third object support flange including means to attach an object, said third object support flange extending from said third portion. New **claim 41** recites a third protrusion, the third protrusion located on the support body whereby the third protrusion cooperates with at least one of the first and second protrusions to increase the resistance to disengagement from said ceiling grid of said banner hanger by engaging a surface on the ceiling grid opposite a surface of the ceiling grid engaged by at least one of the first and second protrusions. Briefly, new **claim 42** recites a fourth protrusion located on the support body.

It is respectfully submitted that at least each of new **claims 34-38 and 41-42** recite subject matter that further distinguishes the subject matter of **claim 11**, from which they depend, from the cited references.

#### **Claims 23-25, 29 and 30 are Not Obvious**

**Claims 23-25, 29 and 30** were rejected under 35 U.S.C. §103(a) as being unpatentable over Condon in view of Schmidt. However, **claim 23** has been amended to recite a first tapered wall depending from a first flange and a second tapered wall



depending from a second flange wherein the first and second tapered walls and a support body cooperate to engage an associated ceiling grid member with a progressively firmer grip as the object hanger is rotated from a disengaged position relative the associated ceiling grid into an engaged position.

In explaining the rejection, the Office Action stipulates that Condon does not disclose protrusions, which are tapered walls. The Office Action relies on Schmidt for disclosure of tapered walls and asserts that the motivation to modify Condon's "protrusions" such that they are tapered walls as taught by Schmidt is to adapt Condon's pipe hanging clamp to the slope of the lower flange of an overhead beam. However, as explained above, there is no motivation in the references themselves or in the art as a whole to adapt the pipe hanging clamp of Condon for use on an I-beam. In fact, Schmidt teaches away from such a modification. Condon teaches a unitary plastic clamp for mounting copper pipe on a HYCO strap. Schmidt explains that various I-beam sizes exist and that I-beam flanges can be from 3 inches to 5 inches wide. Therefore, Schmidt discloses, as best illustrated in FIGS. 4 - 6 an improved hanger plate **25** provided with apertures **26**, which are arranged in substantially elliptical form about a common center. The improvement offered by Schmidt allows one hanger plate to be installed on all of these I-beam sizes. Schmidt explains that the centers of the apertures may be on a line which is substantially elliptical. The hanger plate may be of elliptical form. The apertures are arranged in pairs, the apertures of the respective pairs being at opposite sides of the common center, and the pairs of apertures being located for accommodating I-beams of different sizes (page 1, lines 30-59).

If the hanger plate is to be secured to a 5 inch I-beam, bolts are received in holes marked 5 on the hanger plate. If the hanger plate is to be secured to a 6 inch I-beam, the bolts are received through apertures marked 6 in the hanger plate, and if the hanger plates are to be secured to I-beams of other sizes, the bolts are received in apertures marked correspondingly on the hanger plates (page 1, line 102 - page 2, line 1).

It is the object of Schmidt to provide means for supporting overhead tracks; and, further, to provide a hanger plate in such supporting means arranged to be conveniently attached to the flanges of I-beams of various sizes (page 1, line 1-line 6).

It is respectfully submitted that, in each of these instances, Schmidt teaches away from using a unitary clamp such as the unitary plastic clamp (Abstract) of Condon because a unitary clamp is not adaptable to a plurality of I-beam sizes. Schmidt teaches that multi-piece designs such as that including the hanger plate **25**, bolts **34**,

clamping shoes **28** and nuts **35** disclosed by Schmidt are preferred. Therefore, it would not be obvious to combine the teachings of Schmidt with the teachings of Condon.

For at least the foregoing reasons, there is no motivation in the art for combining Schmidt with Condon. The only motivation to do so is found in the present application. However, use of the present application to supply the motivation for combining Schmidt and Condon is not allowed. Therefore, it is respectfully submitted that the rejections of **claims 23-25, 29 and 30** are based on impermissible hindsight.

For the foregoing reasons, **claims 23-25, 29 and 30** are unanticipated and are not obvious in view of Condon and Schmidt taken alone or in any combination.

The Office Action offers no explanation for the rejections of **claims 24 and 25**. Condon discloses a mounting peg **18**. However, it is respectfully submitted that the mounting peg **18** is not a plateau serving to place the first and second arms into a grip enhancing tension with an associated ceiling grid member when the first and second arms are engaged with the associated ceiling grid member, as disclosed in the present application and recited in **claim 24**. Furthermore, mounting peg **18** is not a friction increasing plateau as disclosed in the present application and recited in **claim 25**. It is respectfully submitted that nothing in Schmidt discloses or suggests the grip enhancing or friction increasing plateaus recited in **claims 24 and 25**.

For at least the foregoing additional reasons, **claims 24 and 25** are unanticipated and are not obvious in light of Condon and Schmidt taken alone or in any combination.

**Claim 29** has been placed in independent form including all the elements recited in the original base **claim 23**. Arguments similar to those submitted in support of **claim 23** are submitted in support of **claim 29**.

Additionally, **claim 29** recites the first and second flanges, carrying the first and second tapered walls, are connected to first and second stems by first and second neck regions respectively. In explaining the rejection of **claim 29**, the Office Action asserts that Condon discloses a neck portion and directs the attention of the Applicants to the portion of **32** connecting the free distal end of **32** with the vertical extending arm connected to **20**. However, Merriam-Webster's Collegiate dictionary, 11<sup>th</sup> Edition, defines neck as a relatively narrow part suggestive of a neck: as a (1): the constricted end of a bottle (2): the slender proximal end of a fruit. It is respectfully submitted that no portion of the L-shaped flanges **32** and **34** of Condon disclose or suggest a relatively narrow, constricted or slender portion or region. For example, the portion of **32**

connecting the free distal end of **32** with the vertically extending arm connected to **20** is the same size as every portion of **32**. Therefore, Condon does not disclose or suggest flanges connected to stems by neck regions.

For the foregoing additional reasons, newly independent **claim 29**, as well as **claim 30** which depends therefrom, is unanticipated and is not obvious in light of Condon and Schmidt taken alone or in any combination.

#### **Telephone Interview**

In the interests of advancing this application to issue the Applicant(s) respectfully request that the Examiner telephone the undersigned to discuss the foregoing or any suggestions that the Examiner may have to place the case in condition for allowance.

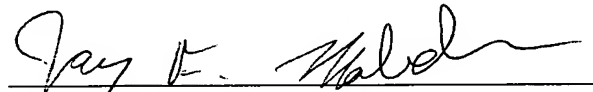
### CONCLUSION

**Claims 1-10 and 13** have been canceled. **Claims 11, 12, 17-25 and 29-33** remain pending. It has been requested that **claims 14-16** be reinstated. **Claims 34-43** have been added. **Claims 29, 31 and 32** have been placed in independent form. For the foregoing reasons, the case is in condition for allowance. Accordingly, an early thereof is requested.

Respectfully submitted,

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18 June 2004  
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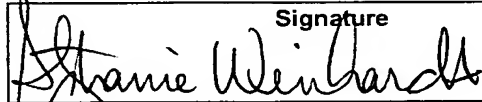
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#### Certificate of Mailing

Under 37 C.F.R. § 1.8, I certify that this Amendment is being

- ☒ deposited with the United States Postal Service as First Class mail, addressed to: MAIL STOP AMENDMENT AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on the date indicated below.
- ☐ transmitted via facsimile in accordance with 37 C.F.R. § 1.8 on the date indicated below.
- ☐ deposited with the United States Postal Service "Express Mail Post Office to Addressee" service under 37 C.F.R. 1.10 on the date indicated below and is addressed to: Commissioner For Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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Date <u>June 18, 2004</u>

Signature 
Printed Name Stephanie Weinhardt